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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,480	06/29/2001	Anthony J. Leone III	D/A0A74	5302
7590	01/25/2005			EXAMINER QIN, YIXING
Patent Documentation Center Xerox Corporation Xerox Square, 20th Floor 100 Clinton Ave. S. Rochester, NY 14644			ART UNIT 2622	PAPER NUMBER
DATE MAILED: 01/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/893,480	LEONE ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Yixing Qin	2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 June 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 June 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11 June 2004.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

I. Claims 8 and 14-18 rejected under 35 U.S.C. 102(b) as being anticipated by Watkins et al (U.S. Patent No. 5,459,819).

The Watkins et al reference discloses an invention for the printing of customized images by combining customer inputted images with prestored images and text.

**8. Claim 8**

**A printing system apparatus for providing a personalized print item from a portable memory device, comprising:**

- **a reader for receiving data from the portable memory device;**
- The Watkins et al reference discloses in Fig. 1 a variety of input devices connected to a CPU. Watkins et al discloses in column 5, lines 63-66 that “...input device 12 scans the film and produces a digital output which is forwarded onto the central processing unit 10 by an appropriate data link system 11 for further manipulation.” Although not explicitly stated, the CPU (which may be a server computer, column 6, lines 49-50) would inherently have to have some reading mechanism for obtaining the digital output to be processed. One

skilled in the art would know that input devices can be read using USB, parallel, serial, network, or other ports on a computer.

- One of the input devices (item 20, column 6, lines 14-16) is a digital camera, which would be considered a portable device with memory.
- **at least one product template stored in a memory;**
- Watkins et al discloses In Fig. 2 (item 100) that a "consumer visually examines and selects a prestored image and selects a desired output format." In column 7, lines 25-28, Watkins et al discloses that "[t]he customer/operator, at decision point 100, also selects the desired output format, for example, if the image is to be placed on a T-shirt, paper, greeting card, photographic paper, or other desired format available. In certain situations, the prestored image selected may not be allowed to be printed in a particular format due to its unsuitability for that particular format; for example, if the selected prestored image does not have the proper resolution for the format selected."
- Although not explicitly called a template, one skilled in the art would understand that the various formats (such as a t-shirt) or a prestored image serves the purpose of being a template since it would be some predetermined design in which to add text or image data to. Also see Fig. 4 and column 9, lines 45-61 for a short description of the locations in the prestored images used for additional text or information.
- Watkins et al discloses in column 7, lines 10-13 that "...a customer and/or operator will visually examine, through the use of the video screen connected to

the CPU 10, a plurality of prestored images provided in the memory of the CPU 10."

- **and a print engine where the reader receives data which is placed into the product template to produce a result that is then printed by the print engine.**
- The Watkins et al reference discloses a variety of output devices coupled to the CPU 10. Watkins et al discloses in column 6, lines 26-48 that the output devices could be a variety of printers. In Fig. 2 (item 114), Watkins et al discloses the printing of the combined and annotated image.

**14. The apparatus of claim 8 further comprising**

- **a scanner which can provide scanned data for placement into the product template.**
- Watkins et al discloses in column 5, lines 59-61, that "...first input device 12 comprises a scanner used to scan photographic negatives or slides, both color and monochrome." Lines 63-66 further discloses that "...input device 12 scans the film and produces a digital output which is forwarded onto the central processing unit 10 by an appropriate data link system 11 for further manipulation."

**15. Claim 15**

**The apparatus of claim 8 further comprising**

- **a camera which can provide image data for placement into the product template.**
- Watkins et al discloses in column 6, lines 14-16, that "[i]Input device 20 comprises a electronic camera such as the DCS 200 Digital Camera, produced by the Eastman Kodak Company." This would be used to obtain pictures for placement into the template.

#### 16. Claim 16

**A method for a printer system to provide personalized print items, the printer system apparatus executing steps comprising:**

- **accessing a portable memory device;**
- Watkins et al discloses in column 5, lines 55-67, and column 6, lines 1-20 a plurality of input devices that can be used to input data to the CPU 10. Items 16,18,20, and 22 could be considered portable memory devices. As explained above in the rejection to the first limitation of claim 8, the CPU would have various ports for reading information.
- **receiving data from the portable memory device;**
- Inherently, the CPU would receive data from the device after having read the data from it. In the case of Watkins et al's invention, the data is in the form of an image.
- **assembling the data into a pre-stored product template found in the printer system;**

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- Watkins et al discloses in Fig. 2 (item 108) that the “consumer selected prestored image is combined with the consumer generated, captured image.” The captured image is the data that is accessed and received from an input device.
- **and printing the resultant personalized print item.**
- Watkins et al discloses in Fig. 2 (item 114) that “the combined and annotated image is printed on an appropriate device to the desired output format.”

#### **17. Claim 17**

**The method of claim 16 further comprising**

- **the step of scanning for image data to be assembled into the product template.**
- Watkins et al discloses in column 5, lines 59-61, that “...first input device 12 comprises a scanner used to scan photographic negatives or slides, both color and monochrome.” Lines 63-66 further discloses that “...input device 12 scans the film and produces a digital output which is forwarded onto the central processing unit 10 by an appropriate data link system 11 for further manipulation.”

#### **18. Claim 18**

**The method of claim 16 further comprising**

- **the step of photographing image data to be assembled into the product template.**

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- Watkins et al discloses in column 6, lines 14-16, that “[i]nput device 20 comprises a electronic camera such as the DCS 200 Digital Camera, produced by the Eastman Kodak Company.” The purpose of the camera would be to photograph images and the image data would be sent to the CPU.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**II. Claims 1-7, 9 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins et al (U.S. Patent No. 5,459,819).**

#### **1. Claim 1**

**A method for a printer apparatus to provide personalized print items, the printer apparatus executing steps comprising:**

- receiving data from a portable memory device;**
- Watkins et al discloses in Fig. 1 a host of input devices (items 12-22) connected to a CPU (item 10). Watkins et al discloses in column 6, lines 10-12 that “...input devices 16,18,20,22 are provided for obtaining digital signals representative of an image from various sources.” As discussed above in the rejection to claim 8, the

CPU can receive data from the devices using various ports. Lines 12-20 discloses that these input devices are portable, such as a CD, digital camera, etc.

- **prompting an operator to select a product template resident in the printer apparatus;**
- From the rejection to claim 8 above, it is understood that the output format (such as a t-shirt) or a prestored image could be a template, since they serve the purpose of having some predetermined design in which to add data to. The decision point 100 (column 7, line 25) could be interpreted as a way of prompting or notifying the user to select some output format. Also, prompting or notifying techniques such as pop-up message boxes are well known (i.e. message box showing yes/no/cancel in most windows applications) and could be written using very few lines of simple code.
- **prompting the operator to select at least one field entry from the data;**
- Watkins et al discloses in Fig. 2 (item 102) and column 7, lines 39-42 that “[t]he customer then reaches the next step illustrated by box 102 wherein the customer provides one or more images as required by the selected prestored image, which are to be combined and merged into the selected prestored image.” Although, not explicitly states, the image selected can be just an entry in a host of images that are stored in, for example, a removable memory device such as a cd-rom. Again, the prompting of a user can be easily done as discussed above.

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- Also, it should be noted that if the limitation implies that the input data is in the form of text, one skilled in the art would know that text can be as easily inputted as images because the reading of both textual and graphical data are both well-known (i.e. one can simply store text instead of images on a cd-rom to be read). Thus, it would be obvious to one skilled in the art to use either text or images as input from the removable memory. The motivation would be to enable users to use different data formats for entry, which in turn provides customers more choices in the types of personalized items to print.
- **assembling the field entry into the product template;**
- Watkins et al discloses in Fig. 2 (item 108) and column 9, lines 39-42 that “[o]nce the customer generated image or images have been properly adjusted, it is combined with the selected prestored image as is represented by box 108.”
- **and printing the resultant personalized print item.**
- Watkins et al discloses in Fig. 2 (item 114) that “the combined and annotated image is printed on an appropriate device to the desired output format.”

## 2. Claim 2

The method of claim 1 further comprising the step of

- **prompting the operator to select a format for the field entry prior to the step of printing the resulting personalized print item.**
- Watkins et al discloses in Fig. 2 (item 106) and column 7, lines 55-61 that “[i]n... box 106, the captured image may be color balanced, and density, contrast

saturation and resolution adjusted, so that the image, when merged into the prestored image, will be properly matched with respect to the selected prestored image so as to provide a uniform and high quality merged image.” It should also be noted that, as mentioned above in the rejection to the second limitation of claim 1, the user selects an output format for the images to be printed on.

- Again, the prompting of the operator can be easily done, as discussed in claim 1.

### 3. Claim 3

#### **The method of claim 2 further comprising**

- **the step of prompting the operator to enter appropriate text prior to the step of printing the resulting personalized print item.**
- Watkins et al discloses in Fig. 2 (item 110) and column 9, lines 42-44 that “[t]he CPU 10 may also provide the user with the ability to add additional graphics/images and/or text to predetermined locations on the prestored image as illustrated by step 110.” Items 61,63,65,67 of Fig. 4 are some examples of text entered.
- Again, the prompting of the operator is not explicitly disclosed, but simple code can be written to provided pop-up message boxes for prompting.

### 4. Claim 4

#### **The method of claim 3 further comprising**

- **the step of prompting the operator to scan an image or input an image from some other source prior to the step of printing the resulting personalized print item.**
- Watkins et al discloses in column 7 , lines 46-50 that “[b]ox 104 (of Fig. 2) illustrates the capturing of the image as is accomplished by input device 14. However, the customer-generated image may be captured by any of the other input devices previously described or any other desired suitable device.” Column 5 lines 59-60 discloses that item 12 is a scanner.
- Again, the prompting of the operator is not explicitly disclosed, but simple code can be written to provided pop-up message boxes for prompting.

## 5. Claim 5

**The method of claim 4 wherein**

- **the other source is the portable memory device.**
- Watkins et al discloses in column 5, lines 55-67, and column 6, lines 1-20 a plurality of input devices that can be used to input data to the CPU 10. Items 16,18,20, and 22 are portable memory devices.

## 6. Claim 6

**The method of claim 4 wherein**

- **the other source is a disk drive.**

- One of the devices mentioned above in the rejection to claim 5 is a compact disc reader (column 6, lines 13-14)

## 7. Claim 7

### **The method of claim 1 further comprising**

- **a earlier prior step of accessing the portable memory device.**
- As mentioned above in the rejection to claim 5, there are a plurality of portable memory devices attached to the CPU 10. It would be inherent for the CPU to access these devices so that information is obtained.

## 9. Claim 9

### **The apparatus of claim 8 further comprising**

- **a software application which provides a user interface upon a display interface to allow the prompting of an operator of the printing system apparatus to specify the contents of the product template.**
- Watkins et al discloses in column 7, lines 20-24 that "t]he CPU is preferably programmed so that the customer/operator may view any of the images on the monitor that have been captured or generated by the CPU 10 so that the desired selections and modifications can be made and viewed at any time."
- Again, the prompting of the user is not explicitly stated, but item 100 is a decision point as mentioned above. Also, simple code can be written to display a pop-up message box to prompt users.

**19. Claim 19**

**The method of claim 16 further comprising**

- **the step of prompting an operator to select a product template resident in the printer apparatus.**
- Watkins et al discloses In Fig. 2 (item 100) that a "consumer visually examines and selects a prestored image and selects a desired output format." In column 7, lines 25-28, Watkins et al discloses that "[t]he customer/operator, at decision point 100, also selects the desired output format, for example, if the image is to be placed on a T-shirt, paper, greeting card, photographic paper, or other desired format available."
- Although not explicitly called a template, one skilled in the art would understand that the various formats (such as a t-shirt) or a prestored image serves the purpose of being a template since it would be some predetermined design in which to add data to.
- The prompting of the operator is not explicitly disclosed by Watkins et al, either. However, simple code can be written to prompt the user to select templates. Such prompts could be a simple message box that pops up.

**20. Claim 20**

**The method of claim 16 further comprising**

- **the step of prompting the operator to select at least one field entry from the data.**
- This claim is the same as the third limitation of claim 1, please refer to the rejection that the third limitation of claim 1.

**21. Claim 21**

**The method of claim 16 further comprising**

- **the step of prompting the operator to enter appropriate text prior to the step of printing the resulting personalized print item.**
- This claim is the same as claim 3, please refer to the rejection of claim 3.

**III.** Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins et al (U.S. Patent No. 5,459,819) in view of the applicant's disclosure of the prior art in the background.

**10. Claim 10**

**The apparatus of claim 9 where**

- **the reader provides wireless transmission to the portable memory device.**
- Although the Watkins et al reference discloses in Fig. 1 that there are connections between the various components, they only disclose that they are "appropriate connections" (column 6, line 8) or "Ethernet" (column 6, line 26).

The applicant however, discloses in the prior art on page 4, lines 32-35 that

"...U.S. Pat. No. 5,982,520 (Weiser et al.) discloses a personal storage device for storing applications and data, including business card information, where the device can be used to exchange, in wireless fashion, business card data with another personal storage device or with a computer..."

- Since both references deal with information exchange, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a reader capable of wireless information exchange in the Watkins et al reference as one of the plurality of input devices. The motivation would be to have a different means for inputting data, which allows reading of a wider variety of devices in which data is stored.

## 11. Claim 11

The apparatus of claim 10 where

- **the reader comprises an RF transponder.**
- Again, this is a specific type of connection that Watkins et al does not explicitly disclose. The applicant however, discloses in the prior art on page 4, lines 27-29 that "...U.S. Pat. No. 5,221,838 (Gutman et al.) discloses an electronic wallet that can access an external computer for data exchange using Radio Frequency (RF), Infrared (IR), or microwave frequency transmission. Portable memory devices manufactured by Palm.TM., Inc., as noted above, use IR transmission to exchange data with a suitably equipped computer or with each other."
- Again, the motivation would be the same as the one in claim 10 above.

## 12. Claim 12

**The apparatus of claim 10 where**

- **the reader comprises an infrared transponder.**
- Again, this is a specific type of connection that Watkins et al does not explicitly disclose. As mentioned above in the rejection to claim 11, Gutman et al discloses an infrared transmission means.
- Again, the motivation would be the same as the one in claims 10 and 11 above.

## 13. Claim 13

**The apparatus of claim 9 where**

- **the reader provides the ability to read magnetic strip-encoded data.**
- Again, this is a specific type of connection that Watkins et al does not explicitly disclose. The applicant however, discloses in the prior art on page 5, lines 11-16 that “[a]lternative types of portable memory devices include cards having an embedded magnetic strip, such as credit cards or ID cards, and Smart Cards that may even include logic processor circuitry...[c]ard-based devices can be easily scanned to read stored data and to provide this data to a printing apparatus, such as for example by swiping cards through a peripheral scanner.”
- Again, the motivation would be the same as the one in claims 10, 11 and 12 above.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is 703-306-4142. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YQ

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